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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,690	01/24/2002	Masahiro Motoyuki	216999US0X RE	8424

22850 7590 10/29/2002

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EXAMINER

DANG, THUAN D

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 10/29/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/053,690

Applicant(s)

MOTOYUKI ET AL.

Examiner

Thuan D. Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3, 14, 24, 25, 30 and 31 is/are rejected.
- 7) ☒ Claim(s) 1-31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The copy of the I.D.S. form filed on 01/24/2002 having been considered by the examiner is enclosed in this Office action.

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

The alterations of the citizenship of Ajit V. Sapre, of the residence of John P. McWilliams and Susan P. Donnelly should be initialed and dated.

### ***Specification***

The abstract of the disclosure is objected to because there are several misspelled words in the specification such as "2,6-dimethylnaphthylene" on column 1, line 9. Correction is required. See MPEP § 608.01(b).

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Objections*

Claims 1-31 are objected to because of the following informalities: It appears to be that there are several misspelled words in claims such as “monoalkynaphthalene” on line 4 of claim 1, “dialkylnaphthalane” on line 6 of claim 1, “dialkynaphthalene” on line 2 of claim 9, “dialkynaphthalene” on line 2 of claim 15, “monoalkynaphthalene” on line 13 and “dialkylnaphthalane” on line 15 of claim 20, “monoalkynaphthalene” on line 25 of claim 20, “monoalkynaphthalene” on line 16, “dialkynaphthalene” on line 19, and “monalkynaphthalene” on line 28 of claim 21, “monoalkynaphthalene” on line 4, “dialkynaphthalene” on line 8, “monoalkynaphthalene” on line 10, “monoalkynaphthalene” on lines 13 and 15 of claim 22, “monoalkynaphthalene” on lines 4, 17, 21, and 22 of claim 23, “monoalkynaphthalene” on line 5 of claim 24, “monoalkynaphthalene” on line 4 of claim 25, “monoalkynaphthalene” on line 5 of claim 26, and “dimethylnaphthlane” on line 8 of claim 27. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

Claims 3, 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the term “said dialkylnaphthalene” on line 2 appears to be --said second dialkylnaphthalene --.

It appears to be that the dependency of claim 14 is claim 10 not claim 7.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 24, 25, 30, and 31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of copending reissue Application No. 10/076,431. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the conflicting application disclose a process for producing 2,6-DAN and polyester resin including an alkylation of naphthalene and monoalkylnaphthalene, two steps of dealkylation, and further steps of converting 2,6-DAN to polyester resins. Minor differences between the claimed process and the conflicting process are that while the conflicting process includes two dealkylation steps, claims 24 and 25 recite one dealkylation steps. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the conflicting process by eliminating one dealkylation step to arrive at the process of present claims since it has been held that deletion of one more elements taught in the applied references, thereby deleting their functions, is an obvious expedient. Particularly if its function (feature) is not desired. *In re Keegan*, 51 CCPA

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1344; 331 F2d 315; 141 USPQ 512 (CCPA 1964). *In re Larson*, 340 F2d 965; 144 USPQ 347 (CCPA 1965). *In re Kuhle*, 526 F2d 523; 188 USPQ 7 (CCPA 1975).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Allowable Subject Matter***

Claims 2-19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 1, 20-24, and 26-29 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuan D. Dang whose telephone number is 703-305-2658. The examiner can normally be reached on Mon-Thu.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knode can be reached on 703-308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Thuan D. Dang  
Primary Examiner  
Art Unit 1764

10076431.1st  
October 29, 2002

A handwritten signature in black ink, appearing to be 'Thuan D. Dang', written in a cursive style.